

AMENDMENT TO THE DRAWINGS

Please replace originally filed sheet containing FIGS. 2A and 2B with the attached replacement sheet containing an amendment to FIG. 2A, but no change to FIG. 2B. The amendment to FIG. 2A consists of the addition of the reference 130.

REMARKS

This is in response to the Office Action mailed October 4, 2005, in which the Examiner rejected claims 1-52. Reconsideration of the application as amended is respectfully requested.

Objection to the Drawings

In Section 1 of the Office Action, the Examiner objected to FIG. 2A as failing to depict reference number 130. With this Amendment, Application has added reference number 130 to FIG. 2A, and requests that the rejection be withdrawn.

Claim Objections

In Section 2 of the Office Action, the Examiner objected to claims 3 and 30 due to an informality. Applicant has made the appropriate corrections to claims 3 and 30, and requests that the objections be withdrawn.

Claim Rejections - 35 U.S.C. §103

In Section 4 of the Office Action, the Examiner rejected claims 1-52 under 35 U.S.C. §103(a) as being unpatentable over EP 0659588 (hereinafter "Kabushiki") in view of Piosenka et al. (U.S. Patent No. 4,993,068). Applicant respectfully believes that the rejections can be withdrawn because the Examiner has failed to establish a *prima facie* case of obviousness against the claims.

To establish a *prima facie* case of obviousness, the prior art references must reference (or references when combined) must teach or suggest all the claim limitations. Additionally, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine reference teachings. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness against independent claims 1, 28 and 41, because the cited references fail to disclose all of the claimed features. With regard to Kabushiki, the Examiner found the reference to disclose all of the claimed features of independent claims 1, 28 and 41 except "that an identification card is scanned to generate the ID data." However, without that critical step, it is not possible for Kabushiki to disclose the "retrieving" and "forming" steps of independent claims 1 and 28, since they each make use of the data retrieved during the non-disclosed card scanning step. More particularly, the cited sections of Kabushiki fail to disclose the retrieval of ID information from ID data that is obtained from scanning an identification card and the formation of an identification card print job using the retrieved ID data.

Accordingly, Kabushiki fails to disclose the steps of "retrieving the ID information from the ID data" and "forming an identification card print job defining an image that includes the retrieved ID information arranged in accordance with a template" as described in claim 1, or "retrieving the textual ID information and the photo from the ID data" and "forming an identification card print job defining an image that includes the retrieved textual ID information and the photo arranged in accordance with a template" as described in claim 28.

With regard to Piosenka et al., the Examiner fails to provide any support for the assertion that the scanning steps of claims 1 and 28 are disclosed. Rather, the Examiner merely recites column 3, line 65 to column 4, line 16 and FIG. 1, which

do not contain any disclosure relating to the scanning of an identification card as described in claims 1 and 28. Accordingly, Applicant submits that Piosenka et al. fail to disclose steps of "scanning an identification card having ID information thereby generating ID data representing the ID information" as described in claim 1, and "scanning an identification card having ID information including textual ID information and a photo thereby generating ID data representing the ID information" as described in claim 28.

With regard to independent claim 41, the Examiner failed to identify where the cited references disclose "a scanning application configured to control the scanner to scan an identification card having ID information and thereby generate ID data representing the ID information" or "an ID card producing application configured to retrieve the ID information from the ID data and from an identification card print job defining an image that includes the retrieved ID information arranged in accordance with a template", as provided in claim 41. As a result, the Examiner has failed to provide any support for the that the elements are disclosed in the references.

Accordingly, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness against independent claims 1, 28 and 41, since the cited references fail to disclose all of the claimed features.

Additionally, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness against independent claims 1, 28 and 41, because there is no suggestion or motivation, outside of Applicant's disclosure, to combine the teachings of the cited references.

The Federal Circuit has stated, "virtually all [inventions] are combinations of old elements." Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983). The Federal Circuit has also found that

rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use a claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention, which would be "an illogical and inappropriate process by which to determine patentability." Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). Accordingly, even seemingly simple changes require a finding of a suggestion in the prior art to make the modification to avoid the improper use of hindsight. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In rejecting independent claims 1, 28 and 41, the Examiner stated that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the use of a card to obtain data instead of capturing all of the data manually again because it is more efficient (i.e. saves times [sic:] since the process is not repeated)." However, the Examiner fails to indicate where the cited references support the finding.

Applicant submits that since no such suggestion or motivation exists in the cited references, the Examiner is forced to rely upon Applicant's disclosure to discern "the obviousness" of the claimed invention even though at the time Applicant made the claimed invention, those of more than ordinary skill in the relevant art had failed to perceive the methods of independent claims 1 and 28, or the system of claim 41. Such use of hindsight is improper. In re Lee, 61 USPQ2d 1430 (Fed. Cir. 2002) ("It is improper, in determining whether a person of ordinary skill in the art would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.'") (quoting W.L. Gore v. Garlock, Inc., 220 USPQ 303, 312-13 (Fed. Cir. 1983)). Accordingly, Applicant submits that the Examiner has failed to establish a *prima facie* case of

obviousness against independent claims 1, 28 and 41, since there is no motivation or suggestion to combine the references.

Additionally, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness against each of the claims that depend from claims 1, 28 and 41, for at least the reasons set forth above, and requests that the rejections be withdrawn.

Conclusion

In light of the above comments and remarks, Applicant submits that the present application is in condition for allowance. Reconsideration and favorable action is respectfully requested.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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